

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on December 29, 2009, and the references cited therewith.

Claims 1-7, 9, 10, 12-16, 18, 19, 21 and 22 are amended. Claims 8 and 17 are canceled. Claims 1-7, 9-16 and 18-22 are pending in this application.

Examiner Interview

Applicants thank Examiner Lam and Supervisory Patent Examiner Mengistu for the courtesy of an Examiner Interview conducted with Applicants' attorney, via telephone, April 28, 2010. A proposed claim amendment was discussed. No agreement was reached.

Claim Amendments

Applicants have amended claims 1, 10 and 19, to generally recite "a book **consisting of** one or more pages of printed material" to clarify that the book does not include, e.g., electronics. Support for this amendment may be found throughout the specification. See, e.g., paragraph [0007] (conventional paper books), paragraph [0018] (traditional paper books), and paragraph [0020] (traditional paper book), of the pre-grant Patent Application Publication of the pending application. No new matter is believed added by these amendments.

Applicants have made further clarifying amendments to the claims to differentiate a "digital page image representing the one or more pages of printed material" from "the one or more pages of printed material". No new matter is believed added by these amendments.

35 USC § 112 Rejection of the Claims

Claims 1, 10 and 19 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Official Action pointed to "pre-existing" as being unclear.

Although Applicants disagree with these rejections, in the interest of furthering prosecution, Applicants have amended the claims, deleting "pre-existing". Applicants therefore respectfully request that this rejection be withdrawn.

35 USC § 102 Rejection of the Claims

Claims 1-5, 8-14, and 17-22 were rejected under 35 USC § 102(b) as being anticipated by Ohara et al. (U.S. Patent No. 5739814), hereinafter “Ohara”. Applicants respectfully disagree with this rejection.

As noted above, Applicants have amended claims 1, 10 and 19 to generally recite “a book **consisting of** one or more pages of printed material”. (Emphasis added.) In contrast, Ohara discloses an “electronic book which can store, in a ROM, a computer program”. See, e.g., Ohara, Abstract. Ohara further discloses:

the present invention has the objective of offering **an electronic book with which the cards, which are the data holder** used by the aforementioned sort of electronic devices for entertainment, learning, and the like, **are structured in a book form**, and are designed to enable easy reading of the data without effort simply by turning the pages. (Emphasis added.) See, e.g., Ohara, col. 2, lines 16-21.

Accordingly, the book of Ohara is an electronic book that includes cards (or sheets) that hold data and/or store in ROM, a computer program. The book of Ohara does not **consist of** printed material, but rather includes numerous other components. In contrast, the pending claims recite a book consisting of one or more pages of printed material. The claimed book does not include electronics, memory (ROM) and is not a data holder used by electronic devices for entertainment, learning and the like. Ohara appears to be devoid of any teaching or suggestion of a book *consisting of* one or more pages of printed material.

Further, Applicants are unable to find any teaching or suggestion of an apparatus or method configured to define an object on a digital page image representing the one or more pages of printed material in Ohara.

For at least these reasons, Ohara cannot anticipate claims 1, 10 and 19 under 35 USC §102(b). Applicants respectfully submit that the claims that depend from claims 1, 10 and 19, respectively, are likewise not anticipated by Ohara, by virtue of their dependencies from claims 1, 10 and 19, as well as for their own teachings. Accordingly, Applicants respectfully request that the rejections of claims 1-5, 8-14, and 17-22 be withdrawn.

35 USC § 103 Rejection of the Claims

Claims 6-7 and 15-16 were rejected under 35 USC §103(a) as being unpatentable over Ohara. Applicants respectfully disagree.

The deficiencies of Ohara, with respect to claims 1, 10 and 19 have been discussed in detail above. Applicants respectfully submit that claims 6-7 and 15-16 that depend from claims 1 and 10, respectively, are patentable over Ohara, by virtue of their dependencies from claims 1 and 10, as well as for their own teachings. Accordingly, Applicants respectfully request that these rejections of claims 6-7 and 15-16 be withdrawn.

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (603-668-6560) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-4238.

Respectfully submitted,

MINERVA M. YEUNG ET AL.

By their Representatives,

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